



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/533,466	03/23/00	COLLART F	21416/90042

HM12/0901

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EXAMINER

OGIHARA, N

ART UNIT

1631

PAPER NUMBER

4

DATE MAILED: 09/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/533,466

Applicant(s)

COLLART ET AL.

Examiner

Nancy Ogihara

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1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

- I. Claims 1-8, drawn to a crystal of IMPDH, classified in class 530, subclass 350.
- II. Claim 9, drawn to a machine readable storage medium storing crystallographic coordinate data, classified in class 345, subclass 521.
- III. Claim 10, drawn to a machine readable storage medium storing 2 sets of data for structure determination, classified in class 345, subclass 521.
- IV. Claim 11, drawn to a method for evaluating association of chemical entity that associates with a molecule or molecular complex, classified in class 514, subclass 1.
- V. Claims 12 and 13, drawn to a method of utilizing molecular replacement to obtain structural information, classified in class 702, subclass 27.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I, IV and V), drawn to protein crystals and crystal structures, and Inventions (II and III), drawn a machine readable storage medium, are unrelated to one another. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions I and IV are separate and distinct as the crystal and methods of preparing and using the crystal of Invention I are not required or encompassed by the method of Invention IV for evaluating the association of a chemical entity with a molecule or molecular complex. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions I and V are separate and distinct as the crystal and methods of preparing and using the crystal of Invention I are not required or encompassed by the method of Invention V for performing molecular replacement in obtaining structure information. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions IV and V are separate and distinct as each method comprises differing steps using differing parameters and criteria, to differing ends. Invention IV ends with the evaluation of association of a chemical entity, while Invention V ends obtainment of structural information, whose

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steps and results are not required or encompassed by the methods of Invention IV. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Inventions II and III are separate and distinct as differing data are stored on each machine readable storage medium, to be used for differing methods to differing ends. Invention II is for graphical display, whereas Invention III is for phase calculation. As such the Inventions would require searching in separate and non-overlapping areas, imposing an undue search burden upon the examiner if not restricted.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Ogihara whose telephone number is (703) 308-9363. The examiner can be reached Monday-Friday from 8:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Michael Woodward can be reached at (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist, whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Group 1631 by facsimile transmission. Papers should be faxed to Group 1631 via the PTO Fax Center located in Crystal Park I. The faxing of such papers must conform with the notice published in the Official Gazette 1096 OG 30 (November 15, 1989). The CMI Fax Center number is (703) 308-4242.

Nancy Ogihara
August 25, 2000


ARDIN H. MARSCHEL
PRIMARY EXAMINER